REMARKS

I. Status of the Application

This paper responds to a non-final Office action mailed June 21, 2005, which rejected claims 1-14 and 16. The application was originally filed with claims 1-15. Following a first Office action, mailed September 13, 2004, Applicant amended claims 1-3, 5-10, and 13-15. In response to a final Office action, mailed February 28, 2005, Applicant filed an RCE which included an after final amendment that amended claim 14, canceled claim 15 without prejudice or disclaimer, and added claim 16. The present paper amends claims 1, 2, 6, 7, 9, 10-12, 14 and 16, and adds new claim 17. Therefore, claims 1-14, 16 and 17 are currently under consideration in the present application. Applicant respectfully requests reconsideration of the pending claims in view of the above amendment and the following remarks. By action taken here, Applicant does not intend to surrender any range of equivalents beyond that needed to patentably distinguish the claimed invention as a whole over the prior art. Applicant expressly reserves all such equivalents that may fall in the range between Applicant's literal claim recitations and combinations taught or suggested by the prior art.

II. Amendment of Claims 1, 2, 6, 7, 9-12, 14 and 16

Applicant has amended claims 1, 6, 9-13 so that they recite specific GABA analogs, namely gabapentin or pregabalin. To avoid any ambiguity, Applicant has also replaced "% weight/volume" in claims 1, 3, 6, 9, 10 and 14 with the (equivalent) concentration descriptor "g per 100 mL." Support for this amendment can be found throughout the specification, including Table 1, page 12. Applicant has amended claim 3 so that it depends on claim 1 and to clarify that the composition may include mixtures of polyhydric alcohols besides glycerol and xylitol. Finally, Applicant has amended claims 1, 3, 6, 7, 9, 14 and 16 to correct grammatical informalities. Applicant submits that the amendment of the claims adds no new matter.

III. New Claim 17

Applicant has added new claim 17, which is similar to claim 14, but requires that the liquid pharmaceutical composition contain xylitol and glycerol. Applicant submits that claim 17 is fully supported in the specification as filed and does not introduce new matter.

IV. Rejection of Claims 1-14 and 16 Under 35 U.S.C. § 112 ¶ 1

The present Office action rejected claims 1-14 and 16 under 35 U.S.C. § 112, first paragraph, as allegedly lacking enablement. According to the Office action, the "specification, while being enabling for the GABA analogs disclosed in the specification, does not reasonably provide enablement for any and all GABA analogs." Applicant submits that this rejection does not apply to pending claims 1-14 and 16 since they recite specific GABA analogs—gabapentin and pregabalin—which are disclosed in the specification.

The Office action also rejected claims 1-14 and 16, contending that the specification does "not reasonably provide enablement for said composition when it contains a polyhydric alcohol." An earlier Office action contended that "WO 99/59573 (page 59, Table 4) discloses that the presence of a polyhydric alcohol in an aqueous gabapentin solution increases lactam formation." The latest Office action states that "Applicants argue that the compositions containing xylitol, samples "e" and "f" in Table 4 of WO 99/59573 do not fall within claims 1-14 and 15, but does not explain why. This is not persuasive since the amounts of gabapentin to polyhydric alcohols are within those of the claims."

Applicant respectfully submits that none of the liquid compositions in WO 99/59573 that contain xylitol—samples "e" and "f" in Example 3 and sample "h" in Example 4—fall within the claims of the present application and therefore all of the claims are properly enabled. As noted above, Applicant has amended the claims so that they recite the concentration of the one or more polyhydric alcohols in terms of "g per 100 mL of the composition." The concentration of xylitol in samples "e" and "f" is 1.5 g of xylitol per total volume of 10 mL or, equivalently, 15 g of xylitol per 100 mL of the

compositions (page 59, lines 1-6). The concentration of xylitol in sample "h" is 100 g of xylitol per total volume of 500 mL or, equivalently, 20 g of xylitol per 100 mL of the composition (page 60, lines 7-10). Since all of he claims require that the one or more polyhydric alcohols comprise at least 25 g per 100 mL of the composition, none of the liquid compositions in WO 99/59573 fall within the claims of the present application. Therefore, Applicant respectfully submits that the claims are properly enabled and requests withdrawal of the rejection.

V. Rejection of Claim 16 Under 35 U.S.C. § 112 ¶ 2

The Office action rejected claim 16 under 35 U.S.C § 112, second paragraph, as allegedly being indefinite. According to the Office action, it is "not clear which disorders are intended to be included." As suggested by the Examiner, Applicant has amended claim 16 so that it uses semicolons to separate each kind of condition. Applicant respectfully requests withdrawal of the rejection.

VI. Rejection of claims 1-14 and 16 Under 35 U.S.C. § 103

The present Office action rejected claims 1-14 and 16 under 35 U.S.C. § 103 as being unpatentable over WO 99/58573. According to a prior Office action, which has been incorporated into the present Office action, "WO 99/59573 (page 50, lines 7-21, pages 58-61, Examples 2 and 3) discloses a liquid composition of a GABA analog comprising a polyhydric alcohol containing 2-6 carbon atoms. It discloses the use of a sweetening agent and a flavoring agent on page 50. The examples further disclose formation of the lactam degradation product is limited by the addition of the polyhydric alcohol." Applicant respectfully submits that claims 1-14 and 16 are patentable over WO 99/59573 and all other references cited in the case.

All of the independent claims now recite that the one or more polyhydric alcohols comprise at least 25 g per 100 mL of the composition (claim 14 and new claim 17) or about 25 g to about 75 g per 100 mL of the composition (claims 1, 6, 9, and 10) or recite that the polyhydric alcohols comprise a combination of xylitol and glycerol (claim 17). Neither WO 99/59573 nor any of the other references cited in the Office Action teaches

or suggests these limitations. Therefore, Applicant submits the references cannot anticipate claims 1-14, 16 and 17.

Furthermore, Applicant submits that WO 99/58573 cannot render the claims obvious. As noted in the application, Applicant has discovered that a GABA analog can be formulated in a stable liquid pharmaceutical composition having low levels of a GABA analog lactam when the pH of the composition is about 5.5 to about 7.0 and when the composition includes one or more polyhydric alcohols. See Specification, page 4, lines 4-7, and page 9, lines 7-9. Nothing in WO 99/59573 teaches or suggests that this pH range and the addition of one or more polyhydric alcohols in the claimed amounts would result in a stable liquid pharmaceutical composition containing a GABA analog.

Moreover, WO 99/59573 teaches away from the use of a polyhydric alcohol in pharmaceutical compositions containing a GABA analog. For instance, Example 2 in WO 99/59573 shows that the addition of a polyhydric alcohol (xylitol, sample "e") to an aqueous gabapentin solution increases lactam formation (compare sample "d" and sample "e" in Table 4). The addition of glycine (sample "f") to an aqueous solution of gabapentin and xylitol appears to decrease lactam formation (compare sample "f" with samples "d" and "e" in Table 4). Thus, WO 99/59573 states that Table 4 "shows that gabapentin in its aqueous solution could be similarly prevented from the degradation with lapse of time (the lactam formation) by the addition of glycine, even in the presence of xylitol," i.e., despite the presence of xylitol (emphasis added).

In a previous after final amendment, Applicant attached a declaration under 37 CFR § 1.132 to support Applicant's assertion that the claimed composition is stable. The § 1.132 declaration provided long-term stability data for a liquid pharmaceutical composition containing gabapentin, two polyhydric alcohols—glycerol and xylitol—artificial flavor and purified water. The composition contained 5 g of gabapentin per 100 mL of the composition, 44 g of glycerol per 100 mL of the composition, and 30 g of xylitol per 100 mL of the composition, and it had a pH ranging at various times from 6.2 to 6.6. This composition is similar to the liquid pharmaceutical compositions shown in Table 1 of the present application and it falls within the scope of at least claim 1.

The data in Table A, which accompanied the § 1.132 declaration, demonstrated that the gabapentin composition is stable. For samples stored at 5°C for up to 24 months, the lactam concentration was 0.1 % or less, based on weight of gabapentin. Likewise, for samples stored at 25°C for 6 months, the lactam concentration was 0.4 % or less, based on weight of gabapentin. These data support Applicant's contention that the claimed compositions are stable.

Applicant respectfully submits that claims 1-14, 16 and 17 are patentable over WO 99/59573 and all references cited in the case and, therefore, respectfully requests withdrawal of the rejection.

VII. Conclusion

In view of the foregoing, Applicant respectfully submits that all pending claims are patentable over the prior art of record. If the Examiner has any questions, Applicant requests that the Examiner telephone the undersigned.

Applicant believes that no fees are due with respect to the filing of this paper. However, if any fees are required in connection with this amendment, please charge deposit account number 23-0455.

Respectfully submitted,

Date: September 21, 2005

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